REMARKS

Claims 1-29 are pending in the Application and all have been rejected in the Office Action mailed on December 13, 2007. Claims 1 and 11 are independent claims. Claims 2-10 and 24-26, and 12-23 and 27-29 depend from independent claims 1 and 11, respectively. No claims have been amended.

The Applicant respectfully requests reconsideration of the pending claims 1-29, in light of the following remarks.

Rejections of Claims

The Office Action Summary states that claims 1-29 were rejected. However, the Detailed Action of the Office Action states that claims 1-3, 5-17, 20-25, and 27 were rejected (in Section 4) and that claims 26 and 28 were rejected (in section 6). There is no Section 5.

The Office Action provides detailed rejections for claims 1-25 and 27 in Section 4, and claims 26 and 29 in Section 6.

Accordingly, the Applicant assumes that the Examiner unintentionally left out Section 5 that details rejection of claim 28. The Applicant respectfully requests that any rejection of claim 28 be set forth in a next non-final Office action.

Claims 1-25 and 27 were rejected under 35 U.S.C. §103(a) as being unpatentable over Johansson et al. (US Patent 5,418,837; hereinafter "Johansson") in view of Bartel et al. USPN 6,754,895 (hereinafter "Bartel"). Claims 26 and 29 were rejected under 35 U.S.C. §103(a) as being unpatentable over Johansson in view of Bartel as applied to claims 11 and 25 and in view of Rasmussen USPN 6,640,334 (hereinafter "Rasmussen"). The Applicant respectfully traverses all the rejections.

Rejection of Claim 1

Claim 1 was rejected under 35 U.S.C. §103(a) as being unpatentable over Johansson in view of Bartel. The Applicant respectfully traverses the rejection.

The Applicant respectfully submits that the Office Action has failed to establish a case of prima facie obviousness for at least the reasons provided below. M.P.E.P.

§2142 clearly states that "[t]he examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness." The M.P.E.P. §2142 goes on to state that "[t]hat the key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR International Company v. Teleflex Inc.* ... noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. The Federal Circuit has stated that "rejections on obviousness cannot be sustained with mere conclusory statements; instead there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *In re Kahn*."

With regard to claim 1, the Applicant agrees with the Office Action that "Johansson doesn't expressly disclose wherein using update information stored in the memory."

However, the Office Action further states that "Bartel discloses that 'The update information can be distributed as a hidden application within new ROM or firmware update ...' (3:22-25). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Johansson and Bartel, because it would enable updating the firmware transparently (Bartel, 3:25 – 30)." Page 3. The Applicant respectfully disagrees.

The Office Action seems to be intimating that "because it would enable updating the firmware transparently" is sufficient "reasoning with some rational underpinning to support the legal conclusion of obviousness," as stated in the MPEP. However, since claim 1 does not disclose "updating the firmware transparently," the Applicant respectfully submits that this reasoning is moot and does not comprise "rational underpinning to support the legal conclusion of obviousness."

Additionally, the Applicant respectfully submits that the combination of Johansson and Bartel does not disclose all the elements of claim 1. For example, claim 1 specifically states "**a memory** comprising at least one of firmware and software ... at least one firmware component, functioning to update at least a portion of at least one of firmware and software **using update information stored in the memory**." The

Office Action seems to be asserting that an update can be made using update information in the "**new** ROM or firmware **update**." However, this clearly does not disclose "update at least a portion of at least one of firmware and software **using update information stored in <u>the memory</u>.**"

Therefore, the Applicant believes that claim 1 is allowable over Johansson in view of Bartel, for at least the reasons set forth above. The Applicant respectfully requests that the rejection of claim 1 under 35 U.S.C. §103(a) be withdrawn.

The Applicant also respectfully submits that because claims 2-10 and 24-26 depend from allowable independent claim 1, claims 2-10 and 24-26 are also allowable, for at least the reasons set forth above.

Rejection of Claim 11

The Office Action states that the independent claim 11 is rejected under 35 U.S.C. §103(a) as being unpatentable over Johansson in view of Bartel. The Applicant respectfully traverses the rejection.

With regard to claim 11, the Applicant agrees with the Office Action that "Johansson doesn't expressly disclose wherein using update information and performing an update of at least a portion of the at least one of firmware and software using at least information from the user removable electronic memory device, if update information for updating the at least one of the firmware is available in the memory."

However, the Office Action then states that "Bartel discloses that 'The **update information** can be distributed as a hidden application **within new ROM or firmware update** ...' (3:22-25). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Johansson and Bartel, because it would enable updating the firmware transparently (Bartel, 3:25 – 30)." Page 7. The Applicant respectfully disagrees.

Claim 11 states:

> A method of updating an updatable electronic device comprising a memory containing at least one of firmware and software, and a user removable electronic memory device, the method comprising:
> retrieving information from the user removable electronic memory device;

determining whether update information for updating the at least one of firmware and software is available in the memory, using information from the user removable electronic memory device;

performing an update of at least a portion of the at least one of firmware and software using at least information from the user removable electronic memory device, if update information for updating the at least one of firmware and software is available in the memory; and

refraining from performing an update of at least a portion of the at least one of firmware and software, if update information for updating the at least one of firmware and software is not available in the memory.

With respect to the rejection of claim 11, the Office Action is arguing similarly as with respect to the rejection of claim 1. That is, the Office Action seems to be intimating that "because it would enable updating the firmware transparently" is sufficient "reasoning with some rational underpinning to support the legal conclusion of obviousness." However, since claim 11 also does not disclose "updating the firmware transparently," the Applicant respectfully submits that this reasoning is again moot and does not comprise "rational underpinning to support the legal conclusion of obviousness."

Additionally, the Applicant respectfully submits that the combination of Johansson and Bartel does not disclose all the elements of claim 11. Claim 11 specifically states "A method of updating an updatable electronic device comprising **a memory comprising at least one of firmware and software**, and a user removable electronic memory device, the method comprising ... performing an update of at least a portion of the at least one of firmware and software using at least information from the user removable electronic memory device, if **update information** for updating the at least one of firmware and software **is available in the memory**." It would seem that the Office Action is asserting, as it did in claim 1, that an update can be made using update information in the "**new** ROM or firmware **update**." However, this clearly does not disclose "performing an update of at least a portion of the at least one of firmware and software using at least information from the user removable electronic memory device, if **update information** for updating the at least one of firmware and software **is available in the memory**."

Therefore, the Applicant believes that claim 11 is allowable over Johansson in view of Bartel, for at least the reasons set forth above. The Applicant respectfully requests that the rejection of claim 11 under 35 U.S.C. §103(a) be withdrawn.

The Applicant also respectfully submits that because claims 12-23 and 27-29 depend from allowable independent claim 11, claims 12-23 and 27-29 are also allowable, for at least the reasons set forth above.

Conclusion

In general, the Office action makes various statements regarding claims 1-29 and the cited references that are now moot in light of the above. Thus, the Applicant will not address such statements at the present time. However, Applicants expressly reserve the right to challenge such statements in the future should the need arise (e.g., if such statements should become relevant by appearing in a rejection of any current or future claim).

The Applicant believes that all of pending claims 1-29 are allowable. Should the Examiner disagree or have any questions regarding this submission, the Applicant invites the Examiner to telephone the undersigned at (312) 775-8000.

A Notice of Allowability is courteously solicited.

Respectfully submitted,

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